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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/691,747

10/22/2003

Jack D. Pryor

PA1548

7767

7590

04/10/2008

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EXAMINER

GETTMAN, CHRISTINA DANIELLE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

04/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|---------------------------------------|--|
| Office Action Summary | Application No. 10/691,747 | Applicant(s) PRYOR, JACK D. | |
| | Examiner CHRISTINA D. GETTMAN | Art Unit 3734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-31,33 and 43-46 is/are pending in the application.
- 4a) Of the above claim(s) 2-7,9-19 and 33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-31,43,46 is/are allowed.
- 6) ☒ Claim(s) 1,20-26 and 44 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2008, has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 20-24, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monroe et al. (U.S. Patent No. 6,113,608). Monroe et al. disclose the invention substantially as claimed including a stent delivery system including a housing (ref. 124, fig. 1), a sheath (ref. 112, Fig. 1), a slider (ref. 120, Fig. 1 by ref. 104, Fig. 1) that is capable of directly contacting and connecting with an engagement plate (there need not be a permanent connection between the two elements; the proximal most plate of section 132 is the farthest point at which the slider may move), an engagement plate (proximal "plate" portion of ref. 132), a source of stored energy being a spring (ref. 160, Fig. 1 acts like a spring), an anchor plate ("plate" just distal of ref. 136, Fig. 1), a

stent constrained by the sheath (ref. 148, fig. 1), an inner member surrounded by the stent (see ref. 108, Fig. 1), a slider movement mechanism (ref. 144, Fig. 1), and means for connecting the slider to the engagement plate (through ref. 104, fig. 1). Monroe et al. do not disclose using a breakaway element or the slider extending through a slot in the housing. Actuation mechanisms that extend through a housing slot are well-known in the art. It would have been obvious to have modified the actuation inflatable element of Monroe et al. with a manual slider in order to activate the piston to move in a proximal direction. Although Monroe et al. do not disclose how the catheter and inflation lumen are sealed onto the proximal-most part of ref. 132, it would be obvious to place a strip of molding, which is well-known in the art, around the opening of the proximal-most element. This provides friction to the elements to prevent longitudinal or rotational movement. This is considered to be a breakaway since there is no other structure associated with the breakaway in the claim limitations. A breakaway element is considered to be an element that creates friction to reduce movement between two elements. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added a strip of molding in the hole of the proximal-most element in order to prevent movement between it and the catheter and inflation lumen.

Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monroe et al., as applied to claim 1 above, in view of Von Oepen et al. (U.S. Patent No. 2006/0142833). Monroe et al. disclose the invention substantially as claimed except for locking protrusions and locking apertures. Von Oepen et al. teach locking protrusions

and locking apertures (ref. 106-108, Fig. 4-6) for the purpose of locking the slider to the engagement plate. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Monroe et al. with locking protrusions and locking apertures in order to prevent the sheath from extending and sliding back over the stent during deployment.

Allowable Subject Matter

Claims 27-31, 43, and 46 are allowed.

Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the combination of recited elements including a method having the steps of manually retracting a slider coupled to a sheath, causing the slider to directly contact and become connected to an engagement plate, wherein manually retracting further includes the step of disengaging the plate from a housing by breaking a breakaway is neither found nor fairly taught in the prior art of record.

Response to Arguments

Applicant's arguments, see pages 11-12, filed November 13, 2007, with respect to the Nobis et al. reference have been fully considered and are persuasive. The rejection of claims 9-12, 13-19, and 56-61, in view of Nobis et al., has been withdrawn.

Applicant's arguments, regarding the Bates et al. reference, the Tsurata et al. reference, and the Schulze et al. reference, do not comply with 37 CFR 1.111(c)

because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINA D. GETTMAN whose telephone number is (571)272-3128. The examiner can normally be reached on Monday-Thursday 6:45 am to 4:30 pm (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/

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Art Unit: 3734

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Primary Examiner, Art Unit 3734

/Christina D Gettman/
Examiner, Art Unit 3734
571-272-3128